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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,400	07/07/2006	Pierre Caron	0604-1014	2518
<div>466 7590 07/21/2010</div> <div>YOUNG &amp; THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314</div>				
EXAMINER				
CAPOZZI, CHARLES				
ART UNIT		PAPER NUMBER		
1716				
NOTIFICATION DATE		DELIVERY MODE		
07/21/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

### Office Action Summary

**Application No.**

10/585,400

**Applicant(s)**

CARON ET AL.

**Examiner**

Charles J. Capozzi

**Art Unit**

1716

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Interval Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Applicant's amendment to claims 12, 13, and 19, filed 4/30/2010, with respect to clarity of "second order" and "setback" have been fully considered. The rejections have been withdrawn.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 11, 12, 13, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Pourrain (FR 1,121,357, translation).**

4. Regarding claim 11, Pourrain teaches a holding ring that comprises a hoop (ring 9, see for example Fig. 3) for encircling a peripheral edge of an element (tube 8), thereby exerting continuous linear contact with said peripheral edge, said hoop (ring 9) forming an arc over more than 180° and being provided at each of its two ends (edges 12, 13; see for example Fig. 2) with an outwardly-directed tab which extend outwardly from the plane of the element (tube 8).

5. Pourrain teaches a holding ring that is capable of holding an optical element for dip treatment since it teaches every element of the claimed apparatus.

6. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

7. Regarding claim 12, Pourrain teaches a hoop (ring 9) that presents an inside face in contact with a peripheral edge of an element (tube 8), said inside face is longitudinally continuous and presents no sharp edge extending across it.

8. Regarding claim 13, Pourrain teaches a tab (edges 12, 13) that present an inside face that extend the inside face of the hoop (ring 9) with longitudinal continuity without any sharp edge extending across it.

9. As mentioned above, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

10. Therefore, although Pourrain does not explicitly teach tabs (edges 12, 13) as *drip tabs*, the structure is capable of disposing surface material flowing along the hoop (ring 9) as the tabs point away from the object to be held.

11. Regarding claims 14 and 15, Pourrain teaches a hoop of the ring appears to form an arc within the scope of the claims (see for example Fig 3).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**14. Claims 16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pourrain (FR 1,121,357, translation) in view of Shimizu (JP 2001-311915, translation).**

15. Regarding claim 16, Pourrain does not *explicitly* teach a hoop (ring 9) that is comprised of *stainless steel spring bands* which are known to be an elastically flexible material.

16. However, in the same field of endeavor, Shimizu teaches a hoop (arms 3a, 3b; para 0024; see for example Fig. 1) that is comprised of *stainless steel spring bands* which are known to be an elastically flexible material for the benefit of securing an element.

17. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use stainless steel spring bands with the apparatus of Pourrain for the benefit of securing an element.

18. Regarding claim 18, Pourrain teaches a hoop that is constituted by a section member of section that presents an inside (implicit of ring 9) for contacting an element, an outside (implicit of ring 9), and two lateral sides (implicit of ring 9).

19. Pourrain does not *explicitly* teach at least one of the inside and the outside of the section of the hoop (ring 9) is connected to the lateral sides via sharp angles.

20. However, Shimizu teaches lateral sides (implicit of arms 3a, 3b) that form a sharp angle with an inside and outside of a section of a hoop (arms 3a, 3b) (see for example Fig. 2).

21. Further, the change in form or shape, without any new or unexpected results, is an obvious engineering design. See *In re Dailey*, 149 USPQ 47 (CCPA 1976) (see MPEP § 2144.04).

22. It would have been obvious to a person of ordinary skill in the art at the time the invention was made for the lateral sizes of the hoop taught by Pourrain to form sharp angles with the inside and outside sections for the benefit of securing an object.

23. Regarding claim 19, Pourrain teaches a ring in which at least one of the inside and the outside of the section of the hoop (ring 9) is concave, thereby forming a setback therein (see for example Fig. 4).

**24. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pourrain (FR 1,121,357, translation) in view of Shimizu (JP 2001-311915,**

**translation) as applied to claim 11 above, and further in view of Molinaro et al (USP 5,149,158).**

25. Regarding claims 17, Pourrain does not explicitly teach the free ends of the tabs (edges 12, 13) being chamfered.

26. However, in the analogous art of work holders, Molinaro teaches that it is well known in the art to chamfer or bevel edges for the benefit of facilitating fluid flow or drainage (col. 3, lines 65-68 through col. 4, line 1; see for example Fig. 1).

27. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine chamfered edges with the previous art combination above for the benefit of fluid flow or drainage.

**28. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pourrain (FR 1,121,357, translation) in view of Shimizu (JP 2001-311915, translation) as applied to claim 11 above, and further in view of Kim (USP 5,857,576).**

29. Regarding claim 20, Pourrain does not explicitly teach that the encircling arc that presents an outside face (implicit of ring 9) possesses *two diametrically opposite striated or striped holding portions*.

30. However, in the analogous art of work holders, Kim teaches it is well known in the art to use striated or striped holding portions (grooves 5a, 5b; col. 2, lines 63-67; col. 3, lines 21-35; see for example Fig. 2 and Fig. 3) on opposite sides of a work holder for the benefit of gripping.

31. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine diametrically opposite striated or striped holding portions with the previous art combination above for the benefit of gripping.

***Response to Arguments***

32. Applicant's arguments with respect to claims 11, 19, and 20 have been considered but are moot in view of the new ground(s) of rejection.

33. Applicant argues on Page 6 of Remarks that Shimizu does not teach a hoop that is capable of exerting continuous linear contact with a lens along its periphery, as recited in amended claim 11.

34. The examiner agrees with applicant's arguments. However, Pourrain teaches a hoop that is capable of exerting continuous linear contact with a lens along its periphery (see for example Fig. 3).

35. Applicant argues on Page 7 of Remarks that Shimizu does not teach two diametrically opposite striated portions, as recited in claim 20.

36. However, as taught by Kim, it is well known in the art to use striated or striped holding portions (grooves 5a, 5b; col. 2, lines 63-67; col. 3, lines 21-35; see for example Fig. 2 and Fig. 3) on opposite sides of a work holder for the benefit of gripping.

37. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use diametrically opposite striated or striped holding portions for the benefit of gripping.

38. Applicant argues on Page 9 of Remarks that Shimizu does not teach a holder that comprises drip-tabs extending away at each end, as recited in amended claim 11.



39. However, Pourrain teaches a holding ring provided with outwardly-directed tabs which extend outwardly from the plane of the element (see for example Fig. 4).
40. As mentioned above, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).
41. Therefore, although Pourrain does not explicitly teach tabs (edges 12, 13) as *drip tabs*, the structure is capable of disposing surface material flowing along the hoop (ring 9) as the tabs point away from the object to be held.
42. Applicant argues on page 9 of Remarks that Shimizu does not teach a hoop with an internal or external section of a concave geometry, as recited in claim 19.
43. However, it appears that the work holders disclosed by both Pourrain (see for example Fig. 3) and Shimizu (see for example Fig. 1) have a concave geometry, which permits the work holders to secure tubular and circular objects.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles J. Capozzi whose telephone number is (571) 270-3638. The examiner can normally be reached on M-F, 8:30am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on 571-272-1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Charles J. Capozzi/  
Examiner, Art Unit 1716

/Parviz Hassanzadeh/  
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